

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: Burgin, et al. : Atty. Ref: 1160215-0538115
Serial No. 09/944,676 : Group Art Unit: 3715
Filed: August 31, 2001 : Examiner: Kathleen Mosser
For: **A SYSTEM AND METHOD FOR AUTOMATED END USER SUPPORT**

**ARGUMENTS IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW**
In accordance with 1296 Off. Gaz. Pat. Office 67 (July 12, 2005)

Mail Stop AF
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Office Action dated April 17, 2009 ("Office Action"), rejected claims 37-53 and 55-56 as obvious over U.S. Published Application 2002/0130895 ("Brandt") in view of U.S. Patent 6,256,620 ("Jawahar") and further in view of U.S. Patent 6,950,852 ("Kobayaghi"). However, as set forth below, the Office Action failed to make out a prima facie case of obviousness for any of the independent claims: claim 37, 45 and 53. Therefore, the applicants request that the panel withdraw the Office Action's rejections, and allow the claims in their present form, or issue a new office action which addresses the deficiencies in the currently cited art. The concise arguments for which review is requested are set forth below.

Claim 37

Claim 37 is directed to a computerized method in which an event is passed from a first frame to a second frame.¹ Claim 37 specifies that the first frame originates from a first domain, that the second frame originates from a second domain, and that both frames are separate from the end user computer where the passing takes place. As these different domains are subject to the consistent page domain requirement, claim 37 specifies that a set of content from the first frame is masked, so that it appears to originate from the second domain.

¹ All limitations discussed in this paragraph are found in clause a of claim 37.

When the Office Action rejected claim 37, it failed to show that the cited art teaches or suggests masking content from the first frame so that it appears to originate from the second domain. In the Office Action, the Examiner conceded those limitations are absent from the primary references (Brandt and Jawahar).² Accordingly, the Examiner had the burden of showing that those limitations were taught or suggested in Kobayaghi.³ Kobayaghi discloses technology for allowing multiple user machines to share browsers.⁴ In Kobayaghi, when a user loads a shared web page, or presses a sharing button, a NodeManager is loaded on the user's machine.⁵ The NodeManager communicates with a PageCommunicator which is embedded in the shared pages. According to Kobayaghi, because "a PageCommunicator and a NodeManager have an identical domain, data can be exchanged avoiding a problem of security regardless of the domain of the page to be embedded." Consequently, Kobayaghi discloses a system in which sharing takes place based on communication between components which "have an identical domain." The Office Action did not explain how the sharing of Kobayaghi teaches or suggests the masking from claim 37. Instead, the Office Action simply asserted that, because Kobayaghi discloses sharing, it would be obvious to combine it with the primary references to obtain the invention of claim 37.⁶ However, **claim 37 recites masking, so the citation of a reference which discloses an entirely different technique for sharing – communication between a NodeManager and a PageCommunicator having identical domains – is insufficient to meet the burden of showing that each limitation is taught or suggested in the cited art.** As a result, the rejection of claim 37 is clearly insufficient and should be withdrawn.

The use of Kobayaghi, despite the fact that that reference teaches a sharing method which does not include masking, is not the only insufficiency in the rejection of claim 37.

² The Office Action, page 4, stated that "Jawahar et al, like Brandt et al fails to teach that the content of the first frame is masked so that it appears to originate from the second frame." The actual language of claim 37 requires that "the set of content is masked such that it appears to originate from the second domain." It is assumed that the reference to originating from the "second frame" in the Office Action is a typographical error.

³ It is well settled that the burden of making out a prima facie case of obviousness lies with the Examiner. *E.g.*, MPEP § 2142, ¶ 1. It is also well settled that part of that prima facie case is showing that all limitations are taught or suggested in the prior art. *E.g.*, *Ex parte Wada*, Appeal No. 2007-3733 (BPAI 2008) ("When determining whether a claim is obvious, an examiner must make 'a searching comparison of the claimed invention – including all its limitations – with the teaching of the prior art.' *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Thus, 'obviousness requires a suggestion of all limitations in a claim.' *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)).").

⁴ Kobayaghi, abstract.

⁵ The loading of the NodeManager, along with the other aspects of Kobayaghi discussed in this paragraph, is disclosed between line 41 of column 3 and line 2 of column 4 of Kobayaghi.

⁶ Office Action at 4 ("[i]t would have been obvious to employ the sharing technique as disclosed by Kobayaghi et al within the systems of Brandt et al and Jawahar et al so as to allow the sharing of content.").

Another insufficiency in that rejection can be found in the assertion that Brandt teaches passing an event to a second frame originating from a second domain. On page 2, the Office Action asserts that Brandt teaches passing a navigation event to a second frame because that reference discloses passing a help signal (asserted to teach the navigation event) to a help window (asserted to teach the second frame). The Office Action argued that the help window originated from a second domain because it originated from “the instructions in the computer memory.” However, even assuming that the Office Action accurately describes Brandt, it does not accurately describe claim 37. Claim 37 does not simply recite passing an event to a second frame originating from a second domain. Claim 37 also recites that the second domain is “separate from the end-user computer.” The recitation in claim 37 that the second domain is “separate from the end-user computer” is not addressed in the Office Action. That unaddressed portion of claim 37 critically undermines the current rejection, because it precludes the argument that the second domain is taught by instructions in computer memory. Thus, **the rejection of claim 37 is clearly insufficient for the additional reason that it relies on the computer memory being treated as the second domain, even though claim 37 specifically recites that the second domain is separate form the end-user’s computer.**

Claims 45 and 53

The flaws noted above in the rejections of claim 37 are also present in the rejections of claims 45 and 53. Like claim 37, both claims 45 and 53 are directed to computerized methods for providing end user support. Also, like claim 37, both claims 45 and 53 require passing an event from a first frame to a second frame. As in claim 37, those frames originate from different domains, and those domains are separate from each other, and from the end-user’s computer. As a further similarity, claim 45 recites that content from the first frame is masked so that it appears to originate from the second domain. While claim 53 does not recite the precise masking limitations from claim 37, it does recite similar limitations of a link from the first frame being encoded to appear to have originated from the second domain. Given that the Office Action did not treat those limitations separately from the masking limitations discussed above, and given that Kobayaghi does not teach concealing (whether by masking, encoding, or otherwise) the domain of *any* information (link or otherwise) from a first frame, the encoding limitations from claim 53 are not materially different from the masking limitations of claim 37 for the purpose of this brief. Indeed, for the purpose of this brief, there is no material difference between claims 37, 45 and 53, because those claims were grouped in the Office Action, and the Office Action did not distinguish between those claims

at all when making its rejections. Accordingly, the applicants submit that the rejections of claim 45 and 53 are clearly insufficient for at least the reasons given above regarding claim 37.

Failure to Explain

Even if the claims are not allowed, the Office Action should be withdrawn, and a new action issued, because the Office Action clearly failed to comply with the federal rules. Under 37 C.F.R. 1.104(c)(2), when a reference is used to reject a claim as obvious, “the pertinence of...[the] reference, if not apparent, must be clearly explained.”⁷ In this case, there are two distinct failures in the explanations provide in the Office Action. First, as set forth above, the Office Action does not even assert that the cited art teaches or suggests the requirement that the first and second domain are separate from the end user computer, or the requirement that content from the first frame is masked such that it appears to originate from the second domain. **Consistent with 37 C.F.R. 1.104(c)(2), the Office Action should have shown where those aspects of the claims could be found in the cited art, and clearly explained the pertinence of the cited portions of the art to the claims.** Second, the Office Action’s application of Brandt and Jawahar to the independent claims appears to be simply a copy of the rejection of claims 37-53 and 56 from the office action mailed June 19, 2007 (“June ’07 Office Action”).⁸ However, between the June ’07 Office Action and the current rejections, the applicants filed an appeal brief which resulted prosecution being reopened without the rejections from the June ’07 Office Action being maintained.⁹ Since the Examiner effectively repeated the rejections from the June ’07 Office Action in applying Brandt and Jawahar, **the Examiner should have answered the arguments presented by the applicants on appeal, and explained why the rejections were now considered proper, despite having been previously withdrawn.**¹⁰ As a result, even if the current claims are not

⁷ 37 C.F.R. § 1.104(c)(2); *see also* MPEP 707.07(f) (“an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application.”)

⁸ Indeed, even the typographical errors in the June ’07 Office Action are reproduced in the current application of Jawahar and Brandt. *Compare* Office Action at 2 (asserting that Brandt teaches “the automated help session corresponding to the determined present navigation location (paragraph 31), as in **claims 37 and 45.**”) *with* June ’07 Office Action at 2 (asserting that Brandt teaches “the automated help session corresponding to the determined present navigation location (paragraph 31), as in **claims 37 and 45.**”) (emphasis, repeated periods, and emphasis of first periods in original).

⁹ The office action mailed July 1, 2008, rejected the claims based only on 35 U.S.C. § 112 ¶ 2, and stated that the arguments against the rejections from the June ’07 Office Action were “moot in view of the new grounds of rejection.”

¹⁰ This is not only required by 37 C.F.R. 1.104(c)(2), but is specifically required by MPEP 707.07(f) (“Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.”).

allowed, the Office Action should be withdrawn, because it clearly failed to provide the explanation required by the federal rules when rejecting the current claims.

Conclusion

For at least the reasons above, it is respectfully submitted that the rejections of the pending claims as obvious are clearly insufficient. Therefore, the applicants request that the panel withdraw those rejections and either allow the pending claims in their current form or issue a new office action which complies with the patent office rules.

The applicants note that due to the length and content restrictions of the pre-appeal review program, this paper does not include all arguments related to the pending claims. To the extent the applicants have not addressed certain aspects of the present rejections, please do not construe the same as an admission as to the merits of the rejections. Indeed, the applicants reserve all rights with respect to arguments not explicitly raised herein.

The Commissioner for Patents is hereby authorized to charge any deficiency or credit any overpayment of fees to Frost Brown Todd LLC Deposit Account No. 06-2226.

Respectfully submitted,

Burgin et al.

By /William S. Morriss/

William S. Morriss, Reg. No. 60,477
Attorney for Applicants
FROST BROWN TODD LLC
2200 PNC Center
201 East Fifth Street
Cincinnati, Ohio 45202
(513) 651-6915